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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,286	10/22/2003	Thomas C. Chuang	0031000	4915
7590	09/28/2005		EXAMINER	
Thomas C. Chuang #408 2201 Laguna St. San Francisco, CA 94115			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/691,286

Applicant(s)

CHUANG, THOMAS C.

Examiner

Dennis Ruhl

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED /15/05 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): none.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: _____.
Claim(s) rejected: 23, 24, 28 and 29.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
13. ☐ Other: _____.


DENNIS RUHL
PRIMARY EXAMINER

With respect to the argument about new matter and the terms “available” and “unavailable” the argument is non-persuasive. Figure 3A which has been relied upon does not show the three status identifiers as claimed. Figure 3A is directed to the DVD in queue list. Where is the “checked out” status shown? The “unavailable” status is not shown. The examiner notes that the specification teaches 3 categories/lists for the status of the disks, which are “checked out”, “DVD’s in queue” and “awaiting release”. This does not provide support for what is claimed. If applicant is correct in that figure 3A shows the status of “available”, where then is support found for the “checked out status” which is what the specification calls “checked out”? Nowhere does the specification disclose the three status identifiers as claimed. Also, applicant has relied upon figure 3A, which is the “DVD’s in queue” list. With respect to the unavailable status limitation, applicant equates this to the list called “DVD’s awaiting release” because they are not yet available. For one status identifier applicant is arguing that the availability column 330 supports what is claimed (within the “DVD in queue list”) but at the same time applicant is relying on the “DVD awaiting release” list itself to provide support for the unavailable identifier. So applicant is arguing that the available status limitation is supported within the DVD in queue list, but the other status identifier is supported by another list itself, the DVD awaiting release list. This makes no sense. The limitations are directed to new matter and the rejection will be maintained.

With respect to the optimization step that searches *all data queue structures* for the occurrence of a disk identifier the examiner still feels the limitation is new matter. Applicant cites paragraph 51 for support. Paragraph 51 states a few things. One is that

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the number of copies owned by the web site is determined. This is not searching the frequency of occurrence in all data queue structures so this does not support what is claimed. Another disclosure in paragraph 51 is that the rental pattern both historical and current across all users is evaluated. What does this mean? Are you only searching the data queue structures for those titles that are checked out? The term rental pattern is vague. It may be that only the actual number that are currently checked out are being looked for, which means that not all data queue structures are being searched because you are not searching the "DVD in queue" list. This language in paragraph 51 does not support what is claimed. The examiner feels that applicant is taking a broad and somewhat vague disclosure and claiming a specific limitation not expressly disclosed or supported by the specification.

For claim 24, the examiner still does not see where "packaging associated with the disk identifier" is disclosed. The rejection will be maintained.

With respect to the 112,1st enablement rejection, as the claims are written, how is one going to determine the optimized price by determining the frequency of occurrence of the disk identifier as claimed? The claim is specifying that the price is determined from just the frequency of occurrence, nothing else, and there is no guidance given on how this is done. The argument about using a baseline price in paragraph 50 is disclosed as one embodiment, with the use of current market rates being another embodiment. Those two manners are separate and distinct from what is claimed. There still has been no discussion as to once you determine how many copies are owned or how many are checked out, how is the price determined from there? One of

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skill in the art would not be able to figure out how to do the optimization as nothing is disclosed about how the actual price is determined based on the frequency of occurrence.

The 112,2nd paragraph rejection is maintained. Applicant's argument mirrors those for the 112,1st rejection, which has been found non-persuasive.